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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,094	04/18/2001	James M. Sheppard JR.	3129	8428

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/837,094	Applicant(s) SHEPPARD, JAMES M.	
	Examiner Jenna-Leigh Befumo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. In view of the Appeal Brief filed on April 21, 2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The 35 USC 103 rejection based on Hobson (4,259,994) in view of Carpenter et al. (5,983,952) is withdrawn since Hobson does not teach having a woven design on both the front and back on the towel, but instead is producing two different towels with different colored designs next to each other on a single loom.

3. The 35 USC 103 rejection based on Sherrill et al. (3,721,273) in view of the Applicant's Admission is withdrawn since it would not have been obvious to use a multi-color towel with a design on the first side and an inverse design on the second side, as the printed towel in the invention of Sherrill et al. because Sherrill et al. discloses using only rayon yarns on the first side of the towel and only cotton yarns on the second side of the towel.

4. The amendment filed on October 1, 2004 has been entered. Claims 1 – 20 are cancelled. Claim 21 has been amended. The pending claims are 21 – 27.

5. The objection to claim 21 is withdrawn due to the amendment clarifying the claim language.

Double Patenting

6. Claims 21 – 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21 – 36 of copending Application No. 09/747,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because the jacquard loom recited in 09/747,529 and the dobby loom recited in this application can be used to produce the same simple fabric construction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 21 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stark (3,669,818) in view of Parker et al. (1,925,459) and Sherrill et al.

Stark discloses a pile fabric having a patterned surface and a design superimposed on the patterned surface for use in carpets, towels, and upholstery (abstract). Further, Stark discloses that there is a continuing desire in the textile field to produce new and aesthetically pleasing textile products (column 1, lines 25 – 29). Various patterns may be produced in the textile fabric itself by varying the construction of the pile surface and using different color yarns to create various parts or sections of the fabrics (column 1, lines 29 – 31 and 40 – 45). Further, Stark discloses that it is known in the art to print patterned pile fabrics in registry with sections of the existing pattern (column 1, lines 45 – 47). The pile fabric can be produced by conventional means, including weaving, to produce a desired pattern in the fabric (column 2, lines 13 – 15). The printing can be applied by various methods including roller printing, screen printing, photographic printing or the

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like (column 2, lines 22 – 25). And the printed design can include multiple colors onto fabrics made from different colored yarns (column 2, lines 23 – 28). Additionally, the pile yarns can be looped yarns or cut yarns (column 2, lines 29 – 30). Finally, Stark discloses that the particular pile pattern used to make the fabric is virtually unlimited, as is the print design to be applied to the fabric, and the final product is governed by the desired visual appearance (column 2, lines 43 – 47).

While Stark discloses fabrics made with different color yarns, Stark fails to teach patterned pile fabrics having a woven two-color design on a first side and the reverse design on the opposite side. Parker et al. is drawn to pile fabrics comprising a woven pattern produced by using contrasting yarns (lines 1 – 5). Stark discloses that the patterned fabric is made up of two different color pile yarns using a first color yarn to form the background of the design and a second color to form the image of the design on the first side of the fabric, while the second side of the fabric is the reverse with the first color forming the image and the second color forming the background (lines 15 – 25). The different colored yarns can be used to form stripes or other designs (lines 13 – 15). Also, the filling yarns can be different colors creating cross borders, or transverse stripes, in the fabric, with the opposite side being a reverse image (lines 28 – 35). Thus, it would have been obvious to one having ordinary skill in the art to use a pile fabric having a first image on the first side and a reverse image on the second side, as disclosed by Parker et al. as the patterned pile fabric in the printed pile fabric disclosed by Stark since Parker et al. discloses a woven patterned pile fabric and Stark discloses that a printed design can be combined with a patterned pile fabric of any construction to produce a visually appealing finished product. Hence, the different colored sections in the fabric taught by Parker et al. can be enriched by applying a printed pattern to the fabric which enhances the desirability of the end product (column 2, lines 48 – 50).

Additionally, Stark discloses that the pile yarns can be cut yarns. Sherrill et al. discloses that a cut pile surface, where the tufts inherently blossom because they are free to spread out and open (column 3, lines 63 – 65), produces a surface which is more receptive to printing and produces a clearer image than a loop pile surface (column 4, lines 18 – 24). Thus, it would have been obvious to one having ordinary skill in the art to apply the print pattern to a sheared and open cut pile surface, as discussed by Sherrill et al., in the patterned fabric disclosed by Stark because the printed image will have better resolution and result in a clearer image than a printed pattern on a loop pile surface.

Stark fails to disclose the height of the sheared pile yarn in relation to the height of the pile on the opposite side. However, shearing the surface of a fabric creates waste by removing the top surface of the pile. Thus, the more the pile is sheared the more fiber which is wasted. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the claimed pile height, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). One of ordinary skill in the art would want to produce a pile height with the least amount of waste, which is expensive, as well as produce a luxurious, thick pile that is appealing to consumers.

And finally, the Applicant recites that the towel retains its preprinted absorbency. Although Stark fail to discuss the preprinted absorbency of the printed fabric, it is reasonable to presume that said limitations would be met by the combination of the two references. Support for said presumption is found in the use of similar materials (i.e. terry cloth towel) and in the similar production steps (i.e. shearing one side of the terry cloth, applying a printed design to the towel surface) used to produce the printed towel. The burden is upon the Applicant to prove otherwise.

While Stark and Parker do not teach specific design patterns, i.e., the specific features of a towel having borders at each edge and a central area where the printing is applied, both Stark and Parker acknowledge that various woven and printed designs are known and can be combined together to form any desired visual appearance. Further, the claimed border feature is created by controlling the location of the colored yarns, and not by changing the overall weave structure of the towel or by adding additional components to the towel. As set forth in § MPEP 1502.01 a “utility patent” protects the way an article is used and works, while a “design patent” protects the way an article looks (35 U.S.C. 171). The ornamental appearance for an article includes its shape, configuration, and/or surface ornamentation applied to the article. The design pattern created by the two yarns in the woven towel controls the way the fabric looks and does not effect the structure of the towel or the way the towel is used. The towel is still made from multiple warp and weft yarns which are woven together to produce a standard terry cloth fabric, even if the yarns used to make the towel are all one color or all different colors. Hence, the pattern of the colored yarns only effects the ornamentation of the fabric and has no effect on the actual structure of the towel.

It has been held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid* , 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Further, it has been held that where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983). In this case, it is felt that there is no functional relationship between the pattern of the colored yarns, i.e., forming a border on each edge, and the woven towel with printing. Because regardless of what color the two sections

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are, the structure of the towel and how the towel works will not be changed. The only difference between a towel with a blue border section and a white center section on the first side, and a towel with a black border section and a yellow center section on the first side, is the appearance of the towel. Even if the towel was a single color or had multiple stripes, instead of a border section on each edge, the towel would still function the same way and have the same structure, i.e., a woven terry cloth towel with a printed design. Hence, the actual design, or location, of the different colored yarns recited in the independent claims is not given patentable weight because it is not functionally related to the substrate and does not distinguish the invention from the prior art in terms of patentability.

Further, it is noted that the applicant's limitations that the fabric is produced on a dobby loom is an apparatus limitation which is not given patentable weight in the product claim. The patentability of the product is based on the structural limitations of that product and not how it is made or what machine is used to make it. Thus, if the claimed product can be made on a different apparatus or by a different process, the claim is unpatentable even though the prior product was made by a different process or apparatus.

Therefore, the claimed features which deserve patentable weight are, the woven towel having two different color yarns which create a first pattern on the a first side having a sheared surface which is 75% to 95% of the height of the pile on the opposite side and an inverse pattern on the reverse side, with a graphic impression printed on one side. And as set forth above, these features are taught by the combination of Stark, Parker et al., and Sherrill et al. And with respect to choosing different towel designs and combining printed designs with woven designs, Stark discloses combining weave designs with printed designs to create various towel products and further teaches it is known to apply the printed design in registry with the pattern of the towel.

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Additionally, Parker et al discloses that different color yarns can be used to produce different color sections in the towel with a reverse image on the opposite side of the towel. Further, the prior art references also disclose that the patterns which can be used to produce the towel design are virtually unlimited. Thus, the prior art teaches applying print to multi-color patterned towels based on the woven pattern of the towel and that patterned towels with a first image on one side and a reverse image on the opposite side are known. Thus, claims 21 – 27 are rejected.

In the event that the specific design and printed image are given patentable weight Sherrill et al. is included in the rejection as evidence that the design claimed by applicant, a border region surrounding a center area with a design or graphic, is known to those in the art. Sherrill et al. is drawn to printed terry cloth towel products. As shown in Figure 1, the towel is produced with the border design on all four edges and a image in the central area created by the border. Thus, Sherrill et al. discloses that the design pattern desired by the applicant, i.e., a border design on all four edges of the towel and image in the center portion of the towel, is known to those in the art.

Therefore, it would have been obvious to one of ordinary skill in the art to create towels with a known design structure, as shown in Sherrill et al., by combining woven patterns with printed patterns as taught in Stark and Parker et al., which teaches creating towels with different colored sections combined with printed patterns to produce a desired finished product. Also, this would create a towel that is visually and texturally appealing due to the printed images, colors, and weave structure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jenna-Leigh Befumo
July 7, 2005



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